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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,461

11/08/2006

Fraser Jon Edmund Johnson

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03/10/2009

Saul Ewing LLP (Philadelphia)

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EXAMINER

NGUYEN, HOANG M

ART UNIT

PAPER NUMBER

3748

MAIL DATE

DELIVERY MODE

03/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,461	Applicant(s) JOHNSON, FRASER JON EDMUND	
	Examiner Hoang M. Nguyen	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment dated January 14, 2009, has been fully considered.

Applicant argued "wave base" is the maximum depth. The Examiner agrees with that and withdraws the 112 rejection. However, Youlton clearly teaches the water base as claimed because if the wave base is the maximum depth, then the bottom is always above the maximum depth.

Applicant argued once again his invention has taut tethers but flexible during the tidal wave. As best understood, the term "taut" in this application is not really taut to the maximum level because the tethers can be further taut and extended. In this case, there is no difference between the claimed invention and the prior art. In this application, figure 1 clearly shows the tethers are not taut at all. Youlton clearly teaches that concept, his tethers are not taut at the maximum level but can be taut if the wave pulls the tethers. Applicant is also reminded that the subjective term such as "taut" carries very little weight in determining patentability. Applicant simply recites the tethers that can be pulled by the wave, Youlton clearly teaches that and the rejection is proper and should be maintained.

Applicant repeated his argument from the previous amendment that his invention is heave-resistance and further explained that his cables are under tension, and the cables in the Youlton are not. The Examiner strongly disagrees because all cables are under tension if there are forces act on the cable. In the wave power plant, all cables

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are under tension if the waves act on the cables. Moreover, the Examiner would like to repeat his opinions in the previous Office Action, please note "heave-resistance" does not mean "non-heave". On page 2, lines 17-23, Applicant clearly discloses that "heave-resistant" can be achieved by tethering the system to the sea bed and the system may be rise and fall with tidal activity. Accordingly, because Applicant admits that his system does rise and fall with tidal activity, the cables in his invention are not different from the prior art.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16, 18, 21, 23-24, 26-29, are rejected under 35 U.S.C. 102(b) as being anticipated by US 5770893 (Youlton).

Youlton discloses a wave energy converter comprising vessel 17, a plurality of chambers 14 having different lengths and draughts to optimize the performance of the wave energy device for different wave periodicity.

Claims 16, 18, 21, 23-24, 26-29, are rejected under 35 U.S.C. 102(b) as being anticipated by US 4123185 (Hagen et al).

Hagen et al discloses a wave energy converter comprising vessel 47, a plurality of chambers 20 having different lengths and draughts to optimize the performance of

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the wave energy device for different wave periodicity. Also, please note the flexible lines 15 and the anchors 16.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 25, 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5770893 (Youlton). Youlton discloses all the claimed subject matter as set forth above in the rejection of claim 16, but does not disclose different types of flow paths, tubes or energy extractor means. However, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to select different types of flow paths, tubes and energy extractors in Youlton for the purpose of achieving appropriate power outputs.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Nguyen whose telephone number is (571) 272-4861. The examiner can normally be reached on Tuesday--Friday from 12:30 AM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang M Nguyen/
Primary Examiner, Art Unit 3748

HOANG NGUYEN
PRIMARY EXAMINER
ART UNIT 3748

Hoang Minh Nguyen
3/10/2009